

Kolb et al.

U.S. Serial No. 10/604,593

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "Invention I", deemed drawn to a solenoid, and corresponding to claims 1-17 and 22-26.

REMARKS

The Examiner has identified two 'inventions' in the pending claims. The Examiner's classification of the 'inventions' include Group I consisting of claims 1-17 and 22-26, drawn to a solenoid and classified by the Examiner in class 335, subclass 220 and Group II consisting of claims 18-21 drawn to a method of manufacturing a solenoid and classified by the Examiner in class 29, subclass 622.

The Examiner states that "[i]nventions I and II are related as process of making and product made." The Examiner further states that:

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case that the product as claimed can be made by another materially different process.

The Examiner has provided no support, such as an example, for the conclusion that the product, as claimed, can be made by another materially different process. MPEP §805(f) states that "[a] product defined by the process by which it can be made is still a product claim [citation omitted] and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process" (Emphasis added). Merely stating that "the product as claimed can be made by another materially different process" is not a demonstration that the product as claimed can be made by another materially different process, as required under MPEP §806.05(f). As a result, rejoinder is required.

The Examiner further states that "[b]ecause these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by[:] their different classifications, ..., the search required for Group II is not required for Group I, ..., and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper." The only reason that the Examiner has provided in support of restriction is the conclusionary statement that the product as claimed can be made by another materially different process. The Examiner has not demonstrated that such is the case. Specifically, in Examiner Note 2 of MPEP §806.05(f), the Examiner is required

Kolb et al.

U.S. Serial No. 10/604,593

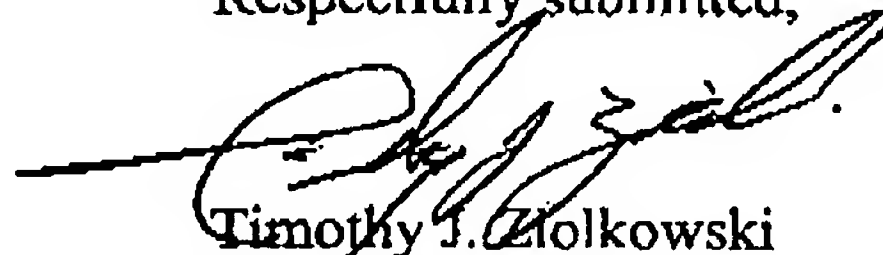
to demonstrate such an assertion by stating that "the process as claimed can be used to make a materially different product such as ..." or stating that "the product as claimed can be made by a materially different process such as" (Emphasis added). Failing to provide an example of a materially different product or a materially different process, as required under MPEP §806.05(f), requires rejoinder of the claims. At least for those reasons argued above, restriction between the claims of Group I and the claims of Group II is not proper.

Additionally, claim 18 of Group II calls for, in part, a method of manufacturing a single coil solenoid including the step of wrapping a single electro-conductive wire around a bobbin. Likewise, claims 1, 11, 22, and 23 of Group I each call for, in part, a solenoid having a single coil of wire. As MPEP §806.05(f) states, "defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention." Applicant has claimed the product of claims 1, 11, 22, and 23 in the process of claim 18. As cited above, such claiming is explicitly permissible under the MPEP.

Additionally, due to the similarity of elements between the claims of Group I and Group II, an examination of the claims of Group II requires a search of the class and subclass of Group I, and vice-versa. That is, examination of either Group I or Group II requires a search of at least all of the classes and subclasses cited by the Examiner. As such, restriction between Group I, consisting of claims 1-17 and 22-26, and Group II, consisting of claims 18-21, is not required.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,


 Timothy J. Ziolkowski
 Registration No. 38,368
 Direct Dial 262-376-5139
tjz@zpspatents.com

Dated: March 12, 2004
 Attorney Docket No.: SSPI0015.001
P.O. ADDRESS:
 Ziolkowski Patent Solutions Group, LLC
 14135 North Cedarburg Road
 Mequon, WI 53097-1416
 262-376-5170